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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,165	02/07/2001	Marc Husemann	Beiersdorf 707	1836

7590 06/05/2002

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-7

**Office Action Summary**

Application No.

09/778,165

Applicant(s)

HUSEMANN ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions wherein the polyacrylate copolymer contains tert-butoxycarbonyl groups and a photoinitiator, does not reasonably provide enablement for polyacrylate copolymers containing hydroxyl groups and no tert-butoxycarbonyl groups and a photoinitiator. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Applicant discloses employing a photoinitiator to deprotect hydroxyl groups that have been protected with tert-butoxycarbonyl groups. If a polyacrylate polymer containing only hydroxyl groups is employed in the adhesive composition (see claim 1 component "a3") no photoinitiator would be required to be present. Applicant's invention appears to be prevention of crosslinking before irradiation to deprotect the hydroxyl groups in the polyacrylate. See page 3, lines 12-25, page 6, lines 1-28.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the word "obtainable" in claim 1 renders the claims indefinite because the polyacrylate may also be obtainable by a different method than set forth in claim 1. It is not clear from the claim language "% by weight based on the polymer mixture of claim 1" whether applicant intends the total weight to be the weight of components a, b and c in the polymer mixture or to be the weight of a

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mixture comprising a, b, c and additional components. Claims 3-6 recite "crosslinking takes place only after the deprotection"; however, the claims do not set forth the method for deprotection of the polymers.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wesp (3,765,972). Wesp discloses adhesive compositions comprising a film-forming latex and a transient tackifier comprising an epoxy resin and a curing agent, such as an amine. The latex can preferably be an acrylic ester-hydroxyl functional monomer copolymer (column 6, line 61, to column 7, line 19). See column 13, lines 36-53 and Example 3. Wesp does not mention adding a photoinitiator.

It would have been obvious to one skilled in the art to employ the compositions disclosed by Wesp to obtain a polyacrylate by thermal crosslinking without addition of a photoinitiator since there are no protected hydroxyl groups to be deprotected. See the rejection of claims 1, 2, 9 and 10 under 35 USC 112, first paragraph set forth above. Claims 1, 2, 9 and 10 encompass compositions wherein the (meth)acrylate "a3" contains hydroxyl groups and no tert-butoxycarbonyl groups.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eichorn et al (5,879,852) disclose a positive-working radiation sensitive mixture containing a polymeric binder having acid-labile groups, such as t-butyl butoxycarbonyl groups, and a compound that forms a strong acid upon irradiation. The disclosed polymeric binders are polyhydroxystyrene, and poly(pyrocatecholmonomethacrylate). Other polymers, such as polyacrylate, can be added (column 5,

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lines 5-13). The compositions can be imagewise exposed to light. Addition of diepoxides or diisocyanates is not mentioned.

Friedrich et al (5,340,946) disclose an adhesive composition comprising a film-forming polymeric resin having hydroxyl, epoxide or unsaturated functionality and a curing agent, such as a blocked polyisocyanate when the functional groups are hydroxyl groups. Polyester, epoxy, polyurethane and phenoxy resins are taught. Poly(meth)acrylate resins are not mentioned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman

Primary Examiner

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SB

5/31/02